



#10
Election
04.29.03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Barry, *et al.*

Appl. No.: 09/987,485

Filed: November 14, 2001

For: **Methods for the In Vivo
Labeling of Peptides**

Group Art Unit: 1648

Examiner: Li, Bao

Atty. Dkt. 7572/73184
(Formerly: 15987/282434)

TECH CENTER 1600/2900

APR 28 2003

RECEIVED

Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated March 26, 2003, in which the Examiner imposed a restriction requirement on the above-captioned application, Applicants hereby elect the inventions of Group I. This includes claims 1-4, 7-9 and 15-17, directed to a fusion protein of a non-envelope virus. In accordance with the requirement set forth in the Office Action, Applicants also elect a PSTCD peptide. It is respectfully requested that claims in non-elected restriction groups II, III and IV, *i.e.*, claims 5, 6, 10-14 and 18-36 be cancelled without prejudice.

This election is made with traverse.

The Examiner indicates that each biotinylation-competent protein or peptide represents a patentably distinct compound and that they are therefore not species. However, these peptides and proteins are, in fact, species of the genus set forth in paragraph a) of claim 1. An evaluation of the patentability of claim 1 would therefore appear to require a consideration of each of the specific compounds recited in the Office Action. Beyond this, the patentability of the individual species depends upon the context in which they are considered

and the prior art that may be identified. With these considerations in mind, Applicants respectfully request that the Examiner reconsider this issue.

Applicants do not believe that any fees, other than those that may be already provided for herewith, are required for the filing of the present document. Nevertheless, any additional fees that may be required may be charged to our Deposit Account No. 06-1135 under order number 7572/73184.

If the Examiner believes that a phone call may help to expedite this matter, the Examiner is invited to call Applicants' undersigned attorney at (202)419-7013.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: Michael A. Sanzo
Michael A. Sanzo
Reg. No. 36,912
Attorney for Applicants

Date: April 24, 2003
1801 K St, NW,
Suite 401L
Washington, DC 20006
(202)419-7013

1648

MORGAN L. FITCH, JR.
 FRANCIS A. EVEN*
 JULIUS TABIN
 JOHN F. FLANNERY
 ROBERT B. JONES
 JAMES J. SCHUMANN
 JAMES J. HAMILL
 TIMOTHY E. LEVSTIK
 JOSEPH E. SHIPLEY
 KENNETH H. SAMPLES
 PHILIP T. PETTI
 JOSEPH T. NABOR
 STEVEN C. SCHROER
 RICHARD A. KABA*
 KARL R. FINK
 MARK W. HETZLER
 TIMOTHY P. MALONEY
 JAMES P. KRUEGER
 STEPHEN S. FAYAKEH
 EDWARD W. GRAY, JR.*
 RICHARD E. WAWRZYNIAK
 STEVEN G. PARMELEE
 SHERRI N. BLOUNT*
 BRUCE R. MANSFIELD
 KENDREW H. COLTON*
 G. PAUL EDGE*
 RICHARD W. SCHUMACHER
 MICHAEL A. SANZO*



FITCH, EVEN, TABIN & FLANNERY

ATTORNEYS AND COUNSELLORS AT LAW

Established in 1859

SUITE 4010 - 1801 K STREET, NW
 WASHINGTON, D.C. 20006-1201

TELEPHONE (202) 419-7000
 FACSIMILE (202) 419-7007

ILLINOIS OFFICE

SUITE 1600 - 120 SOUTH LA SALLE STREET, CHICAGO, ILLINOIS 60603-3406
 TELEPHONE (312) 577-7000

CALIFORNIA OFFICE

SUITE 250 - 9276 SCRANTON ROAD, SAN DIEGO, CA 92121-7707
 TELEPHONE (858) 552-1311

COLORADO OFFICE

SUITE 213 - 1942 BROADWAY, BOULDER, COLORADO 80302
 TELEPHONE (303) 402-6966

April 24, 2003

CHRISTOPHER E. GEORGE*
 SCOTT J. MENGHINI
 EDWARD E. CLAIR
 SANDRA V. SCAVO
 JON A. BIRMINGHAM
 RUDY KRATZ
 RAMON R. HOCH*
 JOHN E. LYHUS
 STEVEN M. FREELAND
 DONNA E. BECKER
 SEAN R. O'DOWD
 MICHAEL G. VRANICAR
 BRIAN S. CLISE
 MARTIN R. BADER
 DEREK L. PRESTIN
 MARK A. BORSOS
 DAVID R. JAGLOWSKI
 W. BRIAN EDGE*

PATENT AGENTS

ERIC J. WHITESELL
 JONATHAN H. BACKENSTOSE
 LILIA I. SAFONOV

OF COUNSEL

THOMAS F. LEBENS
 GEORGE W. SPELLMIRE, JR.
 LISA M. SOMMER

*ADMITTED TO D.C. BAR; D.C. PRACTICE OF
 ALL OTHERS LIMITED TO FEDERAL COURTS
 AND AGENCIES

Assistant Commissioner for Patents
 Washington, DC 20231

Re: Response to Restriction Requirement
 Appl. No.: 09/987,485
 Filed: November 14, 2001
 Title: **Methods for the *In Vivo* Biotin
 Labeling of Polypeptides**
 Inventor(s): Barry, *et al.*
 Atty. Dkt.: 7572/73184 (formerly 15987/282434)

Dear Sir:

The following documents are being forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Response to Restriction Requirement;
2. Change of Address Notice; and;
3. Return Postcard.

Applicants do not believe that any fee is due for the filing of this response as indicated below. However, The Commissioner is hereby authorized to charge any fee deficiency to our Deposit Account No. 06-1135 under Order No. 7572/73184.

APR 28 2003

RECEIVED
 TECH CENTER 1600/2900

Assistant Commissioner for Patents
April 24, 2003
Page 2

CALCULATION OF ADDITIONAL FEES

Applicant(s) have calculated additional fees as follows:

	No. After Amendment	No. Previously Paid for	No. Extra	Rate	Fee
Total Claims Fee	10	37=	0	\$ 18.00	0.00
Independent Claims Fee	1	3 =	0	\$ 84.00	0.00
Multiple Dependent Claims Fee (Previously Paid)	0	0	0	\$ 280.00	0.00
Total Additional Claims Fee					0.00
TOTAL FEES DUE					0.00

It is respectfully requested that the enclosed postcard be stamped with the date the enclosed documents are received by the PTO and that it be returned as soon as possible.

Very truly yours,

FITCH, EVEN, TABIN & FLANNERY



Michael A. Sanzo
Reg. No. 36,912
Attorney for Applicants

MAS:ct
Enclosures